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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,702	11/25/2003	Jonathan S. Stinson	792-64 DIV II	6272
23869	7590	09/18/2006		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 09/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,702

Applicant(s)

STINSON, JONATHAN S.

Examiner

Thomas J. Sweet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30 and 44-75 is/are pending in the application.
- 4a) Of the above claim(s) 45,47-49 and 60-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30,44,46 and 50-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date both 03/28/2005.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 07/27/2006 is acknowledged. The traversal is on the ground(s) that the Examiner has not specifically alleged why the inventions are distinct and no serious burden is required since a co-extensive field of search seems mandated. This is not found persuasive because the Examiner has previously set out why the inventions are distinct. "In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Claim 71 is an evidence claim that the particulars of the subcombination are not necessary for patentability (requires two elements in the volume). The subcombination has separate utility such as suture." To elaborate claim 71 requires two reservoirs per the total element volume while claim 1 only requires one reservoir per the total element volume which are different scopes for the subcombinations (i.e. are patentably distinct). Additionally, the subcombination has utility as a suture or the endoprosthesis of reference US 5358475 (applicable to claims of Group I but not of Group II). The search for each invention requires diverging searches beyond any common search, particularly in term of key word searching.

The requirement is still deemed proper and is therefore made FINAL.

Claims 45, 47-49 and 60-75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/27/2006. Claims 45 and 47-49 have been with drawn as being directed to not

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elected species of figs. 2b and 2d. The disclosure of the species of fig. 2a states hollow member with a (i.e. one) central core (i.e. axially centered), which cannot support claims 45 and 47-49.

***Priority***

The first sentence(s) of the specification following the title must be updated. Application 09/416506 is now Patent number 6652582.

***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 44, 46, and 50-59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buscemi et al (US 5500013). Buscemi et al discloses a bioabsorbable endoprosthesis (18) comprising: at least one elongate element (18) having an outer surface, the element including a bioabsorbable polymer (poly-L-lactide, col 4, line 56) adapted to undergo degradation in vivo (col 4, line 55), the element including an elongate, axially extending reservoir portion (hollow, col 4, line 47) adapted (i.e. in as much as the present invention, since the structure is the same) fully capable of collecting a by-product of the degradation of the bioabsorbable polymer (i.e. since it is hollow, by-products “may at least partially collect”, such as disclosed by the applicant); wherein the at least one element (18) occupies a total element volume including a reservoir volume (hollow space) occupied by the at least one reservoir portion, and the reservoir volume is at least about ten percent of the total element volume (col 4, lines 60-67, .2 mm fiber with a .025 to .1 mm wall is 0-56.25% which encompasses about 10-40%) .

With regard to claim 51, the at least one elongate element is formed into a tubular, radially expandable structure (such as figs. 1 and 3).

With regard to claims 52 and 54, the at least one elongate element (18) comprises a first plurality of elements helically wound (braided, col 4, line 43) about an axis in a first direction, and a second plurality of elements helically wound about the axis in a second direction opposite the first direction to form multiple crossings with the first plurality of the elements (i.e. at any point along a braid there will be “an axis” and the three or more elements required to make a braid helically wind as claimed).

With regard to claim 53, Buscemi et al remains silent as to the specific crossing angles of the braid ranging from about 120 degrees to about 150 degrees. Applicant has not disclosed that having the crossings extending at this range of angles solves any stated problem or is for any particular purpose. Moreover, it appears that the endoprosthesis would perform equally well with the crossings at angle of braid. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify (if not inherently encompassed by a braid) the braid of Buscemi et al such that the cross over angle ranges from about 120 degrees to about 150 degrees because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Buscemi et al.

With regard to claims 55-56, PLLA a polylactide polymer is disclosed (col 4, line 56)

With regard to claim 57, polyglycolide, an others and their combinations are disclosed as suitable biodegradable materials (col 6, lines 11-20).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tormala et al (WO 97/11724) and Mares et al (US 5358475).

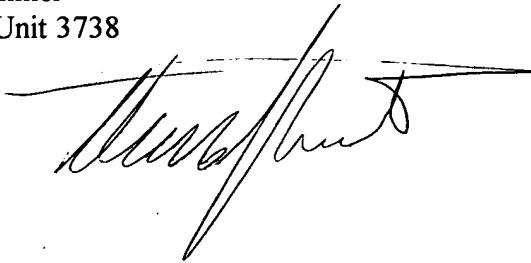
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas J Sweet  
Examiner  
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A handwritten signature in black ink, appearing to read 'Thomas J Sweet', with a long horizontal stroke extending to the right.